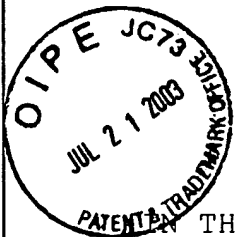


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THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)

F. CESARE)

Serial No. 09/138,926)

Examiner: S. Nolan

Filed: August 24, 1998)

Group Art Unit: 1772

For: LOW MOLECULAR WEIGHT)
POLYMERS AND THEIR USE)
AS DISPERSION AIDS)

#23

RESPONSE

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

This is in response to the Office Action mailed
February 20, 2003, and is accompanied by a request for a
two-month extension of time.

Applicant notes with appreciation the withdrawal of all
of the rejections made in the October 21, 2002 Action. The
new rejections are discussed below.

35 USC §102

Reconsideration and withdrawal of the rejection of
claims 1-6, 8-10, 14-19, 21-22 and 25-30 under 35 USC

\$102(b) as being anticipated by Allen are respectfully requested.

First, it is respectfully submitted that the prosecution history of the present application belies the present assertion of anticipation by Allen. While this is technically the first time that U.S. Patent 4,960,829 has been applied against the present claims, the disclosure of the '829 patent is substantially identical to that of the Allen reference previously cited (EP 0246745 B1).¹ Allen (EP) was first cited in the February 23, 2000 Action, and was relied on in connection with one rejection under 35 USC \$102 (Allen applied to claims 1-4 and 8-10). In the May 23, 2000 Amendment, claims 1 and 14 were amended. In response, the September 25, 2000 Action withdrew all rejections based on Allen (EP). Allen (EP) was not cited in any of the four succeeding Actions prior to the present one. The present claims are no broader than they were on September 25, 2000 when all rejections based on Allen (EP) were withdrawn, and the disclosure of Allen ('829) adds nothing to that of Allen (EP).

¹Indeed, the two references appear to be foreign counterparts of each other. The '829 patent is a continuation of SN 866,854 filed May 23, 1986. EP 0246745 has a single priority claim to that 1986 U.S. application.

The present Action has advanced no reason at all, much less a compelling one, for reploting the same old ground. The present rejection is simply an improper piecemeal examination:

To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and the public, the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied; and in reply to this action the applicant should amend with a view to avoiding all the grounds of rejection and objection. Switching from one subject matter to another in the claims presented by applicant in successive amendments, or from one set of references to another by the examiner in rejecting in successive actions claims of substantially the same subject matter, will alike tend to defeat attaining the goal of reaching a clearly defined issue for an early termination, i.e., either an allowance of the application or a final rejection.

MPEP §706.07. Rejecting the present claims under a reference that was in effect applied over three years ago, and which was withdrawn almost three years ago, simply does not aid in an early termination of proceedings.

When the substance of the rejection is considered, it is clear that Allen ('829) does not anticipate any of the rejected claims, and it is apparent that the rejection is based on a misreading of the reference. Allen discloses that high molecular weight ethylene-propylene copolymers can be blended with low molecular weight materials, and the resulting blends exhibit improved properties compared to high molecular weight materials blended with extender oils.

Notably, Allen discloses that all of its low molecular weight materials are liquid at ambient temperature (col. 4, lines 1-2). In contrast, all of the present claims recite that the claimed polymer is solid at room temperature. The Allen material does not meet that limitation, and there is no anticipation of claim 1, or any claim dependent therefrom. Moreover, Allen does not mention the needle penetration test of claims 9 and 22, and in view of the fact that Allen's low molecular weight materials are liquids, it appears clear that the Allen material would not satisfy claim 9.

In an attempt to equate Allen with the present claims, the Action advances two assumptions: i) that Allen's disclosure of "ambient" means any temperature at which the compositions are processed/cured (165°C and higher), and ii) that the presently claimed compositions would be liquids at those elevated temperatures (Action at 3). The rejection is improper because the first assumption is flatly contradicted by Allen, and the second assumption is irrelevant because it is contrary to the present claims.

In defining "ambient" as an elevated temperature of 165°C or above, the Action ignores Allen's express teaching of what "ambient" means:

The polymers employed in the composition of this invention are liquids at *ambient temperatures, which are between about 20°C and about 40°C.*

Col. 4, lines 1-3 (emphasis added). Thus, there is no basis for the Action's assumption that ambient means 165°C or above.

Compounding the error, the Action speculates that the claimed polymers would be liquid at those elevated temperatures, but that simply does not matter. Whatever form the claimed polymers may have under other temperature conditions, the claims still specify that they are solid at room temperature. The Action attempts to read that element out of the claims by equating room temperature with 165°C or above, but that is both illogical and improper. When the scope of Allen and the present claims are properly considered, there is no anticipation.

35 USC §103

Reconsideration and withdrawal of the rejection of claims 7, 11-13, 20 and 23-24 under 35 USC §103(a) as being obvious in view of Allen are respectfully requested. Allen does not make out a *prima facie* case of obviousness of any of the rejected claims. As discussed above, Allen's lower molecular weight polymers are taught to be liquids at room temperature, whereas the claimed polymers are solids.

There is nothing in Allen that would suggest to one of ordinary skill to vary that physical property of the product.

Moreover, traverse the rejection because the motivation alleged in the Action for one of ordinary skill to increase the amount of alpha-olefin content and to reduce the non-conjugated polyene content (relative costs) is unsupported and hence entitled to no weight.

Applicant submits that the present application is in condition for allowance. Reconsideration and favorable action are earnestly requested.

Respectfully submitted,



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